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| 09/862,728      | 05/22/2001  | Gary K. Starkweather | 1026-037/MMM 160226.1 | 1235             |

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| EXAMINER |
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LE, BRIAN Q

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2621

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/862,728

Applicant(s)

STARKWEATHER, GARY K.

Examiner

Brian Q. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6,8,12-17,19,20,24,25 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 7, 9-11, 18, 21-23, 26 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2005 has been entered.

**Response to Amendment and Arguments**

2. Applicant's arguments with regard to claims 1, 3-4, 7, 9-11, 18, 21-23, and 26 have been fully considered, but are not considered persuasive because of the following reasons:

Regarding claims 1 and 23, the Applicant argues (bottom page 6 or Remarks) that the references teach nothing more than a method of allowing user to view information on a display and thus do not disclose the concept of accessing to the information. The Examiner firmly disagrees. Both references disclose the concept of accessing information, Devito at abstract, first two lines, "A method and system for storing and selective retrieving information (this is accessing) ..." and Hayakawa at FIG. 2, column 3, lines 17-22. The Examiner quite confused of why the Applicant does not recognize that both references teach this limitation. Also, it is clear for one skilled in the art that a system needs to access the information in order to display the information i.e. imaging. Also, Hayakawa teaches the providing access to image file of a next preceding and a next succeeding page of the results page without (devoid) the selected text string (column 3, lines 40-62). Again, Hayakawa does not include the selected text string concept into accessing the image of the next preceding and a next succeeding page. In addition, the Applicant also needs to show the support (exact page number and line number) for this new added

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limitation “wherein each of the next preceding and the next succeeding page is devoid of the selected text string”.

Thus, the rejections of all of the claims are maintained.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3-4, 7, 9-11, 18, 21-23, 26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 1 and 18, the support for the limitation “wherein each of the next preceding and the next succeeding page is devoid of the selected text string” is not found in the original disclosure. The Applicant needs to show the support (exact page number and line number) for this new added limitation.

Claims not specifically addressed are rejected because they are dependent to the rejected claims.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-4, 7, 9-11, 18, 21-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of DeVito U.S. Patent No. 5,825,943 and Hayakawa U.S. Patent No. 6,765,559.

Regarding claim 1, DeVito teaches a document digitizing method of digitizing a document in printed form (column 3, lines 9-12 and FIG. 1), comprising:

Optically scanning the document (FIG. 3, element 200) comprising a plurality of pages (column 2, lines 33-37 and column 3, lines 1-5);

Forming (combine documents) and storing (memory) digitized image files from the plurality of optically scanned pages of the document (FIG. 1, element 106 and column 3, lines 15-18) (column 3, lines 1-8);

Optically recognizing under computer control characters in the plurality of optically scanned pages of the document (column 3, lines 45-50); and

Forming (combine documents) and storing text files of the optically recognized characters in the plurality of pages of the document (column 3, lines 24-30); and, after a search of the document for a results page comprising a selected text string is performed (search phrase) (column 2, lines 29-37).

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DeVito does not explicitly teach the providing access to a digitized image file of at least one of a next preceding and a next succeeding page of the results page. Hayakawa teaches a document imaging storing and retrieving system (FIG. 2(A)) wherein providing an access to a digitized image file of at least one of a next preceding and a next succeeding page of the results page (abstract; FIG. 1; FIG. 13(A) and 13(B); FIG. 14, S6 and S7), wherein each of the next preceding and the next succeeding page is devoid of the selected text string (column 3, lines 40-62). Modifying DeVito's method of digitizing document according to Hayakawa would be able to providing the access and display of digitized image file of at least one of a next preceding and a next succeeding page of the results page and thus enhance the display and access to digitized document data (column 3, lines 40-62). This would improve processing and therefore, it would have been obvious to one of ordinary skill in the art to modify DeVito according to Hayakawa.

Referring to 3, DeVito also teaches the method which a separate text file is formed for each page of the document (display portion of data set shown for each page) (column 2, lines 30-37).

For claim 4, DeVito discloses the method which the document includes plural pages and a separate text file is formed for each page of the document (column 2, lines 30-37).

Regarding claim 7, DeVito further teaches the method which corresponding digitized image files and text files are correlated by a mapping table or algorithm (TIC Table) (column 2, lines 39-41).

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Referring to claim 8, DeVito shows the method comprising retrieving a digitized image file for a document based upon a text string (search phrase for the text file) in the text file corresponding to the digitized image file (column 2, lines 21-28).

For claim 9, DeVito includes the teaching of the method which the digitized image file is compressed and of a lossless image file format (column 3, lines 55-60).

Regarding claim 10, DeVito further discloses the method which the text file is of a simplified file format based upon ASCII characters (column 2, lines 13-15).

Referring to claim 11, DeVito also discloses the method which optical character recognition is applied to all text characters in the optically scanned document (column 2, lines 12-15).

For claim 18, please refer back to claims 1 for further teachings and explanations.

For claim 21, DeVito teaches the method in which searching the text files to identify any having a selected text string includes specifying multiple separate text strings and searching the text files in a batch to identify any text files having any of the separate text strings (FIG. 2, elements 210, 212, and 214).

For claim 22, DeVito teaches the method in which the text files have file names, the method further comprising storing the file names of the text files identified as having the selected text string (column 2, lines 38-44).

For claim 23, please refer back to claim 1 for the teaching. Also, DeVito teaches the software to perform claimed limitations (column 3, lines 24-25).

For claim 26, please refer back to claim 8 for the explanation.

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7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeVito U.S. Patent No. 5,825,943, as applied to claim 1, and further in view of Boyle Pub. No. US 2001/0041021.

Regarding claim 28, DeVito does not explicitly teach the correlation of the text file corresponding to the digitized image file of the document and wherein the digitized image file and text file have common file names and are distinguished by appropriate file extensions. Boyle teaches a document imaging system (abstract) wherein each digitized image file is correlated with a corresponding text file and wherein the digitized image file and text file have common file names and are distinguished by appropriate file extensions (column 3, [0033] and [0040]). Modifying DeVito's method of digitizing document according to Boyle would be able to create a correlation between the image file and the corresponding text file of the document to enhance retrieving and storing processing. This would improve processing and therefore, it would have been obvious to one of ordinary skill in the art to modify DeVito according to Boyle.

#### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Contact Information**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q. Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on 571-272-7695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BL  
January 11, 2006



**SAMIR AHMED**  
**PRIMARY EXAMINER**